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Ole Olsen

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EXAMINER

KURTZ, BENJAMIN M

ART UNIT

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1797

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                     |  |
|------------------------------|--------------------------------------|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/563,346 | <b>Applicant(s)</b><br>OLSEN ET AL. |  |
|                              | <b>Examiner</b><br>BENJAMIN KURTZ    | <b>Art Unit</b><br>1797             |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 107-110, 112-117, 119-121, 123-125 and 127-137 is/are pending in the application.
- 4a) Of the above claim(s) 137 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 107-110, 112-117, 119-121, 123-125 and 127-136 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 107-110, 112-117, 119-121, 123-125, 127-137 are currently pending;  
claims 1-109, 111, 118, 122 and 126 are cancelled.

### ***Election/Restrictions***

1. Newly submitted claim 137 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The filter housing and cartridge of claims 131 and 135 can be made by a different process than rolling such as inserting the perforated core after the roll has been made.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 137 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim 136 amounts to a recitation of only providing the necessary parts to make the apparatus of claim 131. The claim is treated as essentially an apparatus claim as no real method or process steps are recited.

### ***Claim Objections***

Art Unit: 1797

2. Claim 134 is objected to because of the following informalities: There appears to be a typographical error in line 2 of the claim and the claim is assumed to recite "said pores". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 107-110, 112-117, 119-121 and 127-134 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 108 recites that, "...liquid can enter into said bypass spaces and further downstream of said filter can enter into said first filtration medium..." The first filtration medium is part of the filter as recited in claim 131. It is unclear how the liquid can re-enter the filter once it is downstream of the filter. For examination purposes the claim is assumed to read, "...liquid can enter into said bypass spaces and further downstream **in** said filter can enter into said first filtration medium..."

Claim 109 is rejected as depending from claim 108.

Claim 121 recites the limitation "said inner zone". There is insufficient antecedent basis for this limitation in the claim. For examination purposes the filter medium is assumed to have an inner zone.

Claim 131 recites the limitation "the most upstream layer of said first filtration medium" in line 17-18. There is insufficient antecedent basis for this limitation in the claim. For examination purposes the first filtration medium is assumed to have a most upstream layer.

Claims 107-110, 112-117, 119-121 and 132-134 are rejected as depending from claim 131.

Claim 133 recites "said plurality of layers" in line 5. It is unclear what plurality of layers applicant is referring to, (first filtration medium, spacer medium or second filtration medium). For examination purposes "said plurality of layers" is assumed to be the plurality of layer of first filtration medium and spacer medium.

Claim 134 is rejected as depending from claim 133.

Claim 127 provides for the use (method for utilizing) of a filter according to claim 102, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 127-130 are rejected under 35 U.S.C. 101 because the claimed recitation of a use (method for utilizing), without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a

Art Unit: 1797

proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**4. Claims 107, 108, 110, 112, 113, 115-117, 119, 120, 125, 131-134, 135 and 136 are rejected under 35 U.S.C. 102(b) as being anticipated by Hunter US 2 537 897.**

Claims 131, 135 and 136, Hunter '897 teaches a filter house having at least one filter cartridge with a filter, the filter comprising: a plurality of layers of a first filtration medium, each layer having a filtration area and at least one edge, a plurality of layers of a spacer medium, each layer having a filtration area and at least one edge, wherein, the layers of the first filtration medium and spacer medium are positioned alternately and with the filtration area of the layers of first filtration medium and spacer medium faced towards each other, a downstream zone of at least one layer of first filtration medium, positioned downstream in relation to the plurality of layers of spacer medium, a first sealing (21) blocking direct entrance of fluid into at least one edge of the downstream

Art Unit: 1797

zone, a second sealing (20) positioned upstream of the first sealing and downstream of at least one layer of the first filtration medium or the spacer medium, the second sealing blocks direct entrance of fluid into at least one edge of a layer of the first filtration medium or the spacer medium, wherein fluid to be filtered can enter into the filter through the at least one edge of the first filtration medium (fig. 1, 3, 5, col. 1, lines 21-25, lines 45-50, col. 2, lines 19-36).

Claims 107, 108, 110, 132-134, 112, 113, 115-117, 119, Hunter '897 further teaches at least one additional sealing with a distance to the first and second sealing, and wherein the at least one additional sealing seals one or more of the edges of the layers of first filtration medium (fig. 4); the sealings are part of an end cap (4) and the end cap provides open spaces comprising bypass spaces between the sealings, such that filtered fluid can enter into the bypass spaces and further downstream in the filter can enter into the first filtration medium (fig. 5, col. 4, lines 12-25); the first filtration medium and the spacer medium have pores and the pores of the spacer medium are larger than the pores of the first filtration medium (col. 2, lines 19-36); at least one layer of a second filtration medium (col. 2, lines 19-36); the at least one layer of a second filtration medium comprises a plurality of layers of the second filtration medium, each layer having a filtration area and at least one edge, where the plurality of layers are positioned in an alternating structure with the first filtration medium and the spacer medium with the filtration area located towards each other and the first filtration medium and the spacer medium are located in one zone of the filter and the second filtration medium is located in a more upstream zone of the filter in an alternating structure of

Art Unit: 1797

second filtration medium and second spacer medium with the filtration area located towards each other (fig. 1-5, col. 2, lines 19-36); the pores of the first filtration medium are smaller than the pores of the second filtration medium (col. 2, lines 19-36); the first filtration medium is cellulose (col. 1, lines 45-50); the first spacer medium is cellulose (col. 1, lines 45-50); the filter further comprises at least one perforated core (1) (fig. 1); the core is metal (col. 3, lines 11-15); the at least one first filtration medium and the at least one spacer medium are overlying one another and spirally surrounding the central core (col. 1, lines 45-50); and the downstream zone of the first filtration medium forms a zone adjacent to the core of at least one round of the first filtration medium (fig. 1).

Claim 125, the filter house of Hunter '897 would inherently comprise at least one entry port for the contaminated fluid to enter and at least one exit for the clean fluid to exit.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**5. Claims 109 and 121 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter '897 and Hunter et al. US 2 537 898.**



Claim 109, Hunter '897 teaches the filter of claim 108 but does not teach the end cap further comprises perforations.

Claim 121, Hunter '897 teaches the end cap is closed in the area of an inner zone but does not teach the area outside of the inner zone being perforated.

Hunter '898 teaches a filter with an end cap comprising perforations (10) in an area upstream of a sealing (12), such that contaminated fluid can run through the perforations before entering the filtration medium or spacer medium (fig. 1). The claim would have been obvious because the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention, *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (2007).

**6. Claim 123 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter '897.**

Hunter '897 teaches the filter house of claim 135 but does not teach two filter cartridges. Providing two filter cartridges in a housing is known in the filter art to increase capacity and surface area of a filter apparatus and the addition of a second filter cartridge is a mere duplication of parts. Mere duplication of parts has no patentable significance unless a new and unexpected result is produced, *In re Harza*, 124 USPQ 378 (1960).

Art Unit: 1797

**7. Claim 114 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter '897 in view of Novak US 5 744 406.**

Hunter '897 teaches the filter of claim 113 but does not teach the cellulose fibers are made hydrophobic. Novak teaches making cellulose fabrics hydrophobic by treating them with waxes (col. 3, lines 11-21). The claim would have been obvious because a particular known technique was recognized as part of the ordinary capabilities of one skilled in the art, KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (2007). It also would have been obvious because making the filter hydrophobic allows the filter to absorb oily substances.

**8. Claim 124 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter '897 in view of Boogay US 4 299 699.**

Hunter '897 teaches the filter house of claim 135 but does not teach the filter house comprises a container with an opening means. Boogay teaches a filter house comprising a container and the container has at least one opening means (25) through which the filter cartridge may be changed (fig. 1). Having the housing with an opening for replacement of the filter cartridge is very well known in the filter art. The claim would have been obvious because the technique for improving a particular class of devices was part of the ordinary capabilities of a person of ordinary skill in the art, in view of the

Art Unit: 1797

teaching of the technique for improvement in other situations, KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (2007).

### ***Response to Arguments***

9. Applicant's arguments with respect to claims 131 and 135 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 1797

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN KURTZ whose telephone number is (571)272-8211. The examiner can normally be reached on Monday through Friday 8:00am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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